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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/697,222

10/30/2003

Van Dyke Garner

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9784

23504

7590

04/26/2006

WEISS & MOY PC
4204 NORTH BROWN AVENUE
SCOTTSDALE, AZ 85251

EXAMINER

SZEKELY, PETER A

ART UNIT

PAPER NUMBER

1714

DATE MAILED: 04/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding..

Office Action Summary

Application No.

10/697,222

Applicant(s)

GARNER, VAN DYKE

Examiner

Peter Szekely

Art Unit

1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 March 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10, 12-18 and 26-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10, 12-18 and 26-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Objections

1. Claims 1-8, 13-16, 18 and 26-29 are objected to because of the following: "at least one should be followed by a singular, a plural should be followed by "are" and a plural should not be followed by a third person singular. Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-10, 12-18 and 26-33 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a dry powder admixture, does not reasonably provide enablement for liquid, gaseous or wet powder admixture. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims. See page 6, lines 21-22. "Capable for use as a dry powder" does not exclude other forms. Only dry powder admixture, which is lime free, is acceptable.
4. Claims 1-1-, 12-18 and 26-33 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for an dry powder admixture which contains biodegradable ingredients only, does not reasonably provide enablement for an admixture containing non-biodegradable ingredients. The specification does not

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enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims. See page 6, line 35 and page 7, line 1. The claimed rubbers and vinyl esters are not biodegradable. Applicants' response that the claimed admixture embodiments in the amounts specified conforms to the specification is not understood. Please, explain how SBR becomes biodegradable.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

6. Claims 2, 4, 6, 12, 14, 29 and 30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. Claim 2 contains improper Markush language. Proper Markush language, when the last conjunction is "and" is "selected from the group consisting of". Always. Without exception. Claim 4 contains the tradename "vinyl versatate". "Versatic acid" is a tradename also. See Grant & Hackh's Chemical Dictionary, page 619 (enclosed). Claim 6 is indefinite because "less than about" in line 2, vinyl versatate in line 5 and improper Markush language (the "and" is missing) in the penultimate line. Applicants' failed to explain the meaning of "crumb form" in claim 12. Is it powder, particulate, granular or agglomerate? Crumb rubber is vulcanized reground rubber. An explanation is required. Claim 14 and 29 (2X) contain vinyl versatate and in the last line of claim 30, "not less than 4 hours minutes" is incomprehensible.

Claim Rejections - 35 USC § 103

8. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

9. Claims 1-10, 12-18, 26-29 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kono et al. 6,165,263, in view of Emig et al. 4,039,345, Tokumoto et al. 4,710,526 or Dragon et al. 6,075,075.

Response to Arguments

10. Applicant's arguments filed 3/20/06 have been fully considered but they are not persuasive. Applicants are claiming a composition, which is to be added to cement. Kono et al. contain the emulsifiers claimed and they are still there after polymerization. What their role is and what they will do at a later date, when the composition will be finally blended with cement is immaterial. Only claims 30-33 claim a cement composition, the rest claims an admixture for cement. Furthermore, applicants have not proved that the composition of Kono et al., as modified by the secondary references, would not accomplish the tasks, which applicants' claimed composition is capable of achieving. The ratios of ingredients per 1600 lbs of cement in claims 1-10, 12-18 and 26-29 are meaningless, since there is no cement present in those claims. The rejection is maintained.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter Szekely whose telephone number is (571) 272-1124. The examiner can normally be reached on 7:00 a.m.-5:30 p.m. Tuesday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Peter Szekely
Primary Examiner
Art Unit 1714

P.S.
2/25/06